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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,325	04/18/2001	Barclay J. Tullis	2001004	8577

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EXAMINER

PATEL, TULSIDAS C

ART UNIT PAPER NUMBER

2839

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,325

Applicant(s)

TULLIS ET AL.

Examiner

T. C. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 88-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 88-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

General Status

1. This is a Final Action on Merit. Claims 88-111 are pending in the case.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a flat loop, as recited in claim 89 and 93, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 89 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 89, it is not clear what is meant by "a flat loop".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 88-92, 94-99, 102-104 and 109-111 are rejected under 35 U.S.C. 102(b) as being anticipated by Newton et al. (US 4,511,207).

For claims 88, 90, 109, 102, 110, Newton et al. in figures 1-15 discloses an apparatus comprising a first substrate 60 having generally planar top surface with multiple grooves 62a-62n, a first optical fiber 52 having a segment length, the fiber being continuous and unbroken, the fiber having side polished regions at 104a, 104n positioned in respective grooves. For claim 89, fiber loop is shown in figure 5. For claims 91 and 111, the regions of the fiber are capable of participating in a device, such as a coupler, a tap or joiner (see column 10, line 61-63). For claim 92, a second substrate 71 with multiple fibers 11a-11n is shown in figures 15-19 (see column 11, lines 61-67).

For claims 94-97, 99 and 103, two segmented length are show with curvilinear axis also the parallel grooves are shown the fibers in two segments are spaced apart and run in the same direction. For claims 98, 102 and 104 the device can form a tap, see column 10, lines 61-63.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 100, 101, 105-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newton et al. (US 4,511,207).

As discussed above, Newton et al. satisfies the limitations of claim 99. However, Newton et al. does not disclose the dimensions recite in claims 100, 101 and steps of claims 105-108. Using a proper dimension of the substrate is a matter of design choice. Also, for claim 105, with reference to figures 7 and 8, the steps of etching is disclosed in column 8, lines 20-25, lapping or polishing is disclosed in column 10, lines 3-7 and the attachment of the fiber in the V-groove of the substrate by use of adhesive 120 is disclosed in column 9, lines 45-47. For claim 108, forming a tap is disclosed in column 10, lines 61-63. It would have been obvious to one of ordinary skill in the art to provide holding or constraining the components, in order to manufacture precise device.

9. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton et al. (US 4,511,207) in view of Tseng et al. (US 5,809,188).

As discussed above, Newton et al. satisfies the limitations of claim 92. However, Newton et al. does not diffraction device in the four-port device. Tseng et al. discloses a diffraction device in figure 1a. Therefore, it would have been obvious to one of ordinary skill in the art to provide diffraction in one of the fibers so as to make filter or filter.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's invention. Newton et al. (US 4,558,920) Shaw et al. (US 4,676,585; US 4,723,827); Groves-Kirby et al. (US 4,993,797) and Moslehi et al. (US 4,768,850) all disclose fibers with side polish devices.

Applicant also should consider these references in response to this office action. Should issue arise concerning the rejection presented above, these references may be relied upon in a subsequent action to support the lack of novelty or obviousness of claimed subject matter to one of ordinary skill in the art.

Response to Arguments

11. Applicant's arguments with respect to claims 88-111 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. C. Patel whose telephone number is (571) 272-2098. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 271-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. C. Patel
Primary Examiner
Art Unit 2839

Tcp
May 9, 2004